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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,240

04/09/2004

Noel C. Cobb

0075-1

1744

25901

7590

05/22/2008

ERNEST D. BUFF

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

05/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,240

Applicant(s)

COBB ET AL.

Examiner

Jason Prone

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,7 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,7 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on 06 August 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an

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invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 2, 4, 5, 7, and 10-12 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 7, and 10-12 of co-pending patent application 11/352,728. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all elements of claims 2, 4, 5, 7, and 10-12 of the instant invention 10/822,240 are found in claims 2, 4, 5, 7, and 10-12 of patent application 11/352,728. The differences between claims 2, 4, 5, 7, and 10-12 of 10/822,240 and claims 2, 4, 5, 7, and 10-12 of patent application 11/352,728 lies in the fact that the patent application 11/352,728 claims include many more features and is thus much more specific (for example, claim 2 requires "a double-edge blade"). Thus claims 2, 4, 5, 7, and 10-12 of 10/822,240 are in effect a "species" of the "generic" invention of claims 2, 4, 5, 7, and 10-12 of patent application 11/352,728. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 2, 4, 5, 7, and 10-12 of 10/822,240, are anticipated by claims 2, 4, 5, 7, and 10-12 of patent application 11/352,728, it is not patentably distinct from claims 2, 4, 5, 7, and 10-12.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 5, 7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tebo (6,848,185) in view of Anderson (4,109,380) further in view of Burchell (6,321,455). In regards to claim 2, Tebo discloses the invention including a reversible, detachable blade having a flat surface that defines a two-dimensional plane and having a plurality of sharp edges and two anchoring holes (56 in Fig. 2), a handle for supporting the blade (12), a first member and a second member (Fig. 2), a channel means disposed within the handle for containing and supporting the blade (Fig. 2), a locating means disposed within the channel for capturing the blade (20), a cavity for holding extra knife blades (15).

In regards to claim 7, Tebo discloses the locating means is attached to the second member (20).

However, with regards to claims 1, 2, 4, 5, 10, and 11, Tebo fails to disclose the first and second members are substantially V-shaped and together create a substantially V-shaped handle, one leg of the V is a gripping portion and the other leg is a blade supporting portion, the gripping portion is angulated away from the blade, a clamping means for clamping the first and second members and supporting the blade, the angulation ranges from about 135 to about 150

degrees, the clamping means comprises at least one bolt, the bolt is threaded through the first member, and the bolt is slidably fitted to the first member.

Anderson teaches that it is old and well known in the art of utility blades to incorporate first and second members are substantially V-shaped and together create a substantially V-shaped handle (900 and 901), one leg of the V is a gripping portion (side opposite 908) and the other leg is a blade supporting portion (908), the gripping portion is angulated with away from the blade (Fig. 9), a clamping means for clamping the first and second members and supporting the blade (902), the angulation ranges from about 135 to about 150 degrees (Fig. 9), the clamping means comprises at least one bolt (902), the bolt is threaded through the first member (902), and the bolt is slidably fit to the first member (902). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Tebo with the handle, as taught by Anderson because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Anderson teaches that V-shaped handles come in many variations. However, with regards to claim 2, Tebo in view of Anderson fail to disclose the gripping portion is angulated out of the two-dimensional plane.

Burchell teaches it is old and well known in the art of V-shaped knives to incorporate a gripping portion that angulated out of the two-dimensional plan (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art,

at the time of the invention, to have provided Tebo in view of Anderson with the handle, as taught by Burchell because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

Response to Arguments

6. After reviewing applicant's arguments, the previous double patenting rejection was deemed not proper and replaced with the current double patenting rejection. The art rejection remains.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 8:00-5:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20 May 2008

/Jason Prone/

Primary Examiner, Art Unit 3724

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724